



Docket No.: 0905-0236P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Akihisa YAMAZAKI

Application No.: 09/578,679

Confirmation No.: 009832

Filed: May 26, 2000

Art Unit: 2681

For: DATA COMMUNICATION SYSTEM

Examiner: S. B. Smith

REPLY BRIEF

MS Reply Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits herewith a Reply Brief in triplicate as required by 37 C.F.R. § 1.192.

This Brief on Appeal responds to the Examiner's Answer dated June 30, 2005.

For clarity, the issues presented in the Appeal Brief filed April 8, 2005, will be repeated, and the Reply to the Examiner's Answer will correspond structurally to the arguments section in the Appeal Brief.

I. ISSUE ON APPEAL

The issue to be resolved in this application is:

Whether claims 1-8 are anticipated under 35 U.S.C. § 102(b) by the teachings of *Mizikovsky* (USP 5,559,860) (hereinafter “*Mizikovsky*”).

II. NEW POINTS OF ARGUMENT RAISED BY THE EXAMINER’S ANSWER

Appellant is providing this Reply Brief to respond to new points of argument raised in the Examiner’s Answer. Appellant does not disagree with paragraphs (1) – (8) of the Examiner’s Answer. The specific new points of argument that are raised in paragraph (11) to which the Appellant disagrees are as follows:

1. Examiner introduces new arguments and relies on a theory of inherency to support the Examiner’s assertion of anticipation. Appellant’s response to these assertions is discussed in paragraphs C.– E.
2. The Examiner introduces new support for the purported anticipation of “the reception-incapable data transmitting unit” of claim 3, citing to column 12, lines 38-44 of *Mizikovsky*. Appellant’s response to this assertion is discussed in paragraph G. below.

III. REPLY

A. Argument Summary

The Examiner's new assertions of inherency are improper as the disclosure of *Mizikovsky* fails to inherently teach those claimed features as purported by the Examiner. Further, the Examiner's new citations to the teachings of *Mizikovsky* fail to establish *prima facie* anticipation of the claimed invention.

B. Legal Requirements

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re *Rijckaert*, 9 F.3d. 1531, 1534, 28 USPQ.2d 1955, 1957 (Fed. Cir. 1993).

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re *Robertson*, 169 F.3d. 743, 745, 49, USPQ.2d 1949, 1950-51 (Fed. Cir. 1999).

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

C. *Mizikovsky* Fails to Teach or Suggest a First Data Receiving Unit of Independent Claim 1

In responding to Appellant's arguments that the cited reference fails to teach or suggest all of the claim elements, i.e., a first data receiving unit wherein the received data includes information identifying the received data as voice, text, image, or moving picture data, the Examiner responds in the Examiner's Answer on page 11 as follows:

...the user sets up the caller ID to store the information that identifies the caller, the mobile determines which peripheral response category that has been assigned to the calling party and based upon the peripheral response category assigned, the mobile transmits the data to the assigned peripheral, this inherently teaches "identifying" the received data as voice or text image or moving picture data.

However, *Mizikovsky* discloses that a user may assign a response category to the assembled calling party identifying data, based upon the type of call that the user is expecting from that telephone number. Upon receipt of a telephone call, the caller ID processor 44 determines the caller's telephone number and processes the telephone call based upon the response category that the user has assigned to that telephone number. It may be appreciated by one skilled in the art that any one of voice, text, image, or moving picture data may be sent from the telephone number. When the user assigns a response category, an incoming telephone call is processed based upon the assigned response category and not based upon whether or not the received data is one of voice, text, image, or moving picture data. As such, it is not inherent that if a user, for example, assigns a response category to be sent to facsimile, that the data necessarily is data for the facsimile machine. It is possible that a caller can send from a facsimile machine, text data to be printed out on the facsimile machine or voice data (should the user telephone the receiver with the telephone handset). The system of *Mizikovsky* is not be able to

determine which of these two types of data is be received at the mobile telephone. *Mizikovsky*'s system would merely forward the data to a facsimile machine based upon the pre-assigned response category. Should a caller wish to use the handset at the facsimile machine, the caller would be forwarded automatically to the facsimile machine.

As such, Appellant maintains that the Examiner's technical reasoning supporting the assertion that the claim element is inherently taught is erroneous as the conclusion that *Mizikovsky* discloses identifying the data does not necessarily flow from the teachings or the prior art.

As such, Appellant maintains that it is not inherent that *Mizikovsky* discloses receiving data including information identifying the received data a voice, text, image, or moving picture data as purported by the Examiner. Appellant maintains that the cited reference fails to teach or suggest this claim element and as such, *Mizikovsky* fails to anticipate the claimed invention.

D. *Mizikovsky* Fails to Teach or Suggest an Incoming Voice Alert Generating Unit as set Forth in Independent Claim 1

In response to Appellant's argument that the reference fails to teach or suggest all of the claim elements, namely, an incoming voice-alert generating unit, the Examiner response on page 11-12 in the Examiner's Answer as follows:

The alert generator is activated to generate a distinctive ringing indication which represents a priority phone call, this inherently teaches that the data received in voice data otherwise the data would have been sent to the assigned peripheral. In further support of the examiner's position the examiner additionally points out that *Mizikovsky* teaches in column 6 lines 15-33, "a caller ID processor 44, a caller ID memory 46, an alert generator 48, an accessory device (or devices) 50 and a peripheral interface 52. Caller ID processor 44 is couples to keypad 42 and is

operable in a programming, or set up, mode to assemble identifying data representing a particular calling party as may be generated by the operation of the keypad. The caller ID processor also is adapted to generate data representing a response category that the user wishes to assign to the assembled calling party identifying data.

However, as noted above, *Mizikovsky* teaches assigning a response category based upon the type of data the user believes will be received from a certain telephone number, not what type of data is actually sent. It is possible that a caller may send text data from a telephone number that the caller usually uses to have a telephone conversation with the user. There is no determination as to the type of data that being sent in the system of *Mizikovsky*. As such, it does not necessarily flow from the disclosure in *Mizikovsky* that the incoming-voice alert generating unit issues an incoming-call alert when data that has been received by the first data receiving unit represents voice data.

As such, Appellant maintains that the Examiner's technical reasoning supporting the assertion that the claim element is inherently taught is erroneous as the conclusion that *Mizikovsky* discloses the incoming-voice alert generating unit does not necessarily flow from the teachings or the prior art.

As such, Appellant maintains that it is not inherent that *Mizikovsky* discloses the incoming-voice alert generating unit issuing an incoming-call alert when data that has been received by the first data receiving unit represents voice data. Appellant maintains that the cited reference fails to teach or suggest this claim element and as such, *Mizikovsky* fails to anticipate the claimed invention.

E. *Mizikovsky* Fails to Teach or Suggest an Incoming Image Alert Generating Unit as set Forth in Independent Claim 1

In response to Appellant's argument that the reference fails to teach or suggest all of the claim elements, namely, an incoming image-alert generating unit, the Examiner response on page 12 in the Examiner's Answer as follows:

In further support of the examiner's position, the examiner points to column 7 lines 21-27 if a facsimile response category is assigned to a particular calling party, an incoming call received from that calling party activates facsimile device 52a and initiates an appropriate communication protocol at interface 52 such that an incoming facsimile message is received and indicia are printed automatically, this inherently teaches the "alert" being the printing of the fax.

However, claim 1 recites, *inter alia*, a data communication system comprising a mobile telephone, wherein the **mobile telephone** includes an incoming-image alert generating unit. Appellant maintains that the Examiner's reliance on actions by the facsimile machine, which is not a part of the mobile telephone, is insufficient to anticipate the mobile telephone including an incoming-image alert generating unit.

As such, Appellant maintains that the Examiner's technical reasoning supporting the assertion that the claim element is inherently taught is erroneous as the conclusion that *Mizikovsky* discloses the mobile telephone including an incoming-image alert generating unit does not necessarily flow from the teachings or the prior art.

As such, Appellant maintains that it is not inherent that *Mizikovsky* discloses the mobile telephone including an incoming-image alert generating unit. Appellant maintains that the cited reference fails to teach or suggest this claim element and as such, *Mizikovsky* fails to anticipate the claimed invention.

F. *Mizikovsky* Fails to Teach or Suggest a Data Receiving Unit and an Incoming Call Alert Generating Unit as set Forth in Independent Claim 2

In response to Appellant's argument that the reference fails to teach or suggest all of the claim elements, namely, a data receiving unit, the Examiner again relies on a theory of inherency to support the Examiner's assertion of anticipation. Appellant's response to this new theory is set forth above with regard to claim 1.

In response to Appellant's arguments that the reference fails to teach or suggest an incoming call alert generating unit, the Examiner fails to address this argument other than to restate the column and line she asserting in the original rejection. Appellant's arguments against the rejection are set forth in Appellant's Appeal Brief on pages 10-12.

For the reasons noted above, Appellant maintains that *Mizikovsky* fails to anticipate claim 2.

G. *Mizikovsky* Fails to Teach or Suggest a Reception-Incapable Data Transmitting Unit as set Forth in Dependent Claim 3

In response to Appellant's argument that the reference fails to teach or suggest all of the claim elements, namely a reception-incapable data transmitting unit, the Examiner response on page 13 in the Examiner's Answer as follows:

In further support of the examiner's position the examiner additionally points out that Mizikovsky teachings in column 12 lines 38-44, a scrambler if the user had assigned to this calling party (which reads on an undistinguishable call) a scramble-type response, then instruction 518 serves to activate the scrambler and the mobile station then communicates with the calling party by way of the scrambler.

However, the present invention set forth in claim 3 recites the mobile telephone further comprising a reception-incapable data transmitting unit which, when the image processing unit is incapable of receiving data, is for transmitting data indicative thereof to the communication apparatus that transmitted the data. The citation relied upon by the Examiner teaches nothing about an image processing unit. Further, there is no discussion in this citation that teaches or suggests the mobile telephone communicating with the caller to notify the caller that the mobile telephone was incapable of receiving the data. *Mizikovsky* merely describes employing an accessory device, namely a scrambler, to facilitate communication.

As such, Appellant maintains that *Mizikovsky* fails to disclose the reception-incapable data transmitting unit as claimed and, thus, *Mizikovsky* fails to anticipate the claimed invention.

H. The Examiner Fails to Respond to Appellant's Arguments of Claims 5-8

In response to Appellant's arguments of claim 5, the Examiner appears to assert an inherency theory as set forth in the Examiner's arguments of claim 1. Appellant's response to this theory is set forth above with regard to claim 1.

In response to Appellant's arguments of claims 6-8, the Examiner merely repeats certain citations previously set forth in the claim rejection. Appellant's response to these assertions are set forth on pages 18-20 of Appellant's Appeal Brief.

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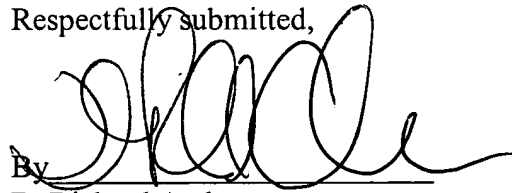
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IV. CONCLUSION

For all of the reasons set forth above, each of the rejections in the Examiner's Answer dated June 30, 2005, is improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

Dated: August 29, 2005

Respectfully submitted,



By D. Richard Anderson

Registration No.: 40,439

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant